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ALVAREZ, R

| ART UNIT | PAPER NUMBER |
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DATE MAILED:

03/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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| Office Action Summary | Application No. 09/207,954 | Applicant(s) Yeh et al. |
| | Examiner RAQUEL ALVAREZ | Group Art Unit 2761 |
| |  | |

Responsive to communication(s) filed on Dec 9, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 35-37 is/are allowed.

Claim(s) 1-34 and 38-44 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Claims 1-44 are presented for examination.

Claim Rejections - 35 U.S.C. § 112

2. Claims 4, 7 and 8 recite "said subscriber" but there is insufficient antecedent basis for this limitation in the claims. Correction is required.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that forms the basis for the rejection under this section made in this office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 14 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al. (5,974,398).

With respect to claims 14 and 31, Hanson teaches receiving via Internet demographic information corresponding to a subscriber(col. 2, lines 55-, col. 3, lines 1-4 and col. 4, lines 54-60); assigning to said subscriber a storage space, said storage space configured to store a personal message to said subscriber(col. 5, lines 3-21); delivering to said subscriber a marketing message corresponding to said demographic information when said subscriber accesses said personal message(Figure 3).

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Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15, 16, 17, 32, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson.

With respect to claims 15, 16, 32 and 33, Hanson teaches assigning to said subscriber a telephone number and an e-mail address corresponding to said storage space such that said personal message corresponds to a voice message(i.e. the customer can consent to receive a sales call by telephone so that a personalized message based on that customer's demographic can be delivered to the customer)(col. 5, lines 50-, col. 6, lines 1-5); receiving said message via telephone or e-mail (i.e. the message can be supplied by telephone); storing said voice message in said storage space(col. 5, lines 3-21); and retrieving said voice message or e-mail from said storage space(col. 5, lines 3-21). Hanson does not specifically teach that the retrieving of the voice message or e-mail is prior to the delivering step nevertheless it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included retrieving the voice message prior to having the marketing message that corresponds to the customer

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demographic information delivered because such a modification would notified the customer that a personalized message would be forthcoming.

Claims 17 and 34 further recite assigning a password corresponding to said storage space and delivering said messages to the subscriber if the password corresponds. Hanson further teaches a database wherein service issues such as security, passwords, and the like is stored(col. 4, lines 54-60) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included having the customer use the passwords before the delivery of the messages because such a modification would provide security(col. 4, lines 54-60).

7. Claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, 41 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann et al. (5,933,778 hereinafter Buhrmann) in view of Civanlar (EP 0 732 835 A 2 hereinafter Civanlar).

With respect to claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, Buhrmann teaches receiving a time, a date and telephone number for a reminder telephone call(col. 11, lines 34-66); storing in a database said time, date and telephone number of said reminder telephone call(i.e. the alert processor scans the subscriber profile stored in the database to obtain the alert message information, such at the time that the alert message is to be delivered, the date and the telephone number that the alert message is to be delivered to)(col. 11, lines 34-66); and delivering said reminder telephone call at said specified time, date and telephone number(i.e. the alert message(reminder message) is sent to its destination)(col. 11, lines 34-, col. 7, lines 1-17).

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Buhrmann teaches delivering the message over telephone. Buhrmann does not specifically teach that the step of receiving the information is via the Internet. On the other hand, Civanlar teaches providing a client-server architecture utilizing the Internet and public switched networks wherein it receives the client information over the Internet connection and handles the client's request by using the telephone number provided by the client (col. 6, lines 34-, col. 7, lines 1-7). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving the information via the Internet and delivering the service over the telephone because such a modification would guarantee quality of service, security, and easy and flexible mechanism to charge for the information and transmission services which are all expected from a complete information network (col. 1, lines 20-25).

With respect to claims 38 and 41, the claims differ from claim 1 in that it further recites that the reminder is for an e-mail message rather than for a reminder telephone call. Official notice is taken that is old and well known to obtain and being able to interchange the use of the telephone with e-mail and get similar results.

With respect to claims 42 and 43, the claims further recite receiving from a subscriber a name and a topic. Official notice is taken that is old and well known for e-mail to contain the name of the sender along with the topic of the message. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a name and a topic for the specific e-mail message because such a modification would allow the receiver to know who the sender is and what the message is about before the message is open.

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With respect to claims 9, 26 and 44, the claim further recites receiving from the subscriber a specifiable number corresponding to a number of e-mail messages. Since, in Buhrmann the subscriber can specify the number of alert messages that he or she wants to receive at a specified time period specified by the customer (col. 11, lines 34-, col. 12, lines 1-17). If the receiving step was to be performed by e-mail then it would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to have included an specifiable number corresponding to the number of message that the customer is to received to obtain the benefits above mentioned.

8. Claims 2, 3, 6-8, 10, 19, 20, 23, 24, 25, 27, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann et al. (5,933,778 hereinafter Buhrmann) in view of Civanlar (EP 0 732 835 A 2 hereinafter Civanlar) further in view of Hanson et al. (5,974,398 hereinafter Hanson).

With respect to claims 2, 19 and 39, Buhrmann further teach that the telephone call further comprises a message (col. 11, lines 29-, col. 12, lines 1-17). The combination of Buhrmann and Civanlar does not specifically teach that the message is a marketing message. On the other hand, Hanson teaches sending marketing message to the subscriber based on the customer's interest profiles and service usage (Abstract). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included including modifying the message of Buhrmann with marketing message because such a modification would provide a more productive message that the customer most likely be interested in.

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With respect to claims 3, 20 and 40, the combination of Buhrmann and Civanlar further teach receiving via the Internet information corresponding to a subscriber and delivering the message during a reminder telephone call. The combination of Buhrmann do not specifically teach that the information is demographic information and matching the marketing message to the demographic information. On the other hand, Hanson teaches obtaining demographic information to enable marketing message to be delivered based on the particular client's demographic(Figures 1-15). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included obtaining demomographic information and using the demographic information to market the messages because such a modification would provide a more productive message that the customer most likely be interested in.

With respect to claims 6 and 23, Hanson further teaches that the information is selected from a group consisting of news and information (col. 3, lines 13-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the information selected from a group consisting of news and information because such a modification would provide a variety of information available to the client based on their interests and likes.

With respect to claims 7 and 24, Hanson further teaches receiving a signal from the subscriber during the delivery of the corresponding marketing message and delivering to said subscriber additional information corresponding to said marketing message(i.e. in response to the user having selected one of several advertisers, a corresponding message with additional

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information on the selected message is retrieved and delivered to the customer)(col. 10, lines 53-, col. 11, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included additional information corresponding to the marketing message in response to receiving a signal from the customer because such a modification would help better target the advertisement based on the particular customer tastes and likes.

Claims 8 and 25 further recites that the signal is generated by pressing a button on the telephone. Since, in Buhrmann the delivery of the messages is via a telephone then it would have been obvious to press a button on the telephone to receive the user's selections.

With respect to claims 10 and 27, Hanson further teaches that the additional information comprises a hyperlink text(col. 10, lines 53-65). It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to have included supplying the additional information via a hyperlink text because such a modification would provide easier access to the additional information.

Allowable Subject Matter

9. Claims 35-37 are allowed.

The Examiner asserts that a method for a communication server to deliver a marketing message wherein it receives a telephone call from a caller at said server; querying said caller for a third-party telephone number; initiating a telephone conference call between said caller and a third-party at said third-party telephone number and delivering to said caller and said third-party a

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marketing message during said telephone conference call, in combination with the other limitations of the claims is not taught in the prior art of record.

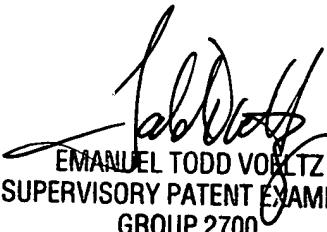
Points Of Contact

10. Any inquiry concerning this communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703) 305-0456. The examiner can normally be reached on Monday to Friday from 9:00 AM. To 5:00 PM.

If any attempt to reach the examiner by telephone is unsuccessful, The examiner's supervisor, Todd Voeltz can be reached on (703) 305-9714. The fax phone number for this group is (703) 305-0040.


Raquel Alvarez

Patent Examiner, AU 2761
March 9, 2000


EMANUEL TODD VOELTZ
SUPERVISORY PATENT EXAMINER
GROUP 2700